

REMARKS

I. Introduction

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-23 are requested to be cancelled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

Claims 24 and 34 are currently amended. Claim 43 is new. Support for the claim amendments and new claim may be found throughout the application and on pages 19-20 of the specification.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

Upon entry of this Amendment, claims 24-43 will remain pending in the application. Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

II. Response to Issues Raised by Examiner in Outstanding Office Action

a. Oath/Declaration

The Examiner asserts that a new oath/declaration must be filed because the present oath identifies application no. 09/336,428. Applicants note that the present application is a continuation of 09/33,428 and note that MPEP § 201.06(c) does not require a newly executed oath or declaration in a continuation or divisional application such as this one. Applicants request withdrawal of this objection.

b. Claim Rejections - 35 U.S.C. § 102

Claims 24, 25, 27, 30-34, 41, and 42 are rejected under 35 U.S.C. § 102 as being anticipated by Rusz (US 5,546,931). Applicants respectfully request reconsideration and withdrawal of the rejection.

The Office asserts that Rusz does not teach a bypass valve. Office Action, p. 2. Applicants believe that the claims previously identified a bypass valve as part of the claimed system. However, in order to expedite prosecution, Applicants have amended claims to recite a bypass valve. Applicants do not believe that the scope of claim 24 has been changed by this amendment, rather, Applicants wish to further the prosecution of this file in light of the Office's comments.

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. As the Office has conceded that Rusz does not teach a bypass valve, Rusz can not serve as an anticipatory reference for the above claims. Applicants respectfully request reconsideration and withdrawal of the rejection.

c. Claim Rejections - 35 U.S.C. § 103

Claims 28, 29, 35, and 36 are rejected under 35 U.S.C. § 103 as being obvious over Rusz in view of Lewis (US 5,571,401). Additionally, claims 26 and 37-40 are rejected under 35 U.S.C. § 103 as being obvious over Rusz in view of Georgieff (US 5,520,169). Applicants respectfully request reconsideration and withdrawal of the rejection.

To establish a *prima facie* case of obviousness, there needs to be (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) the prior art references, when combined, must teach or suggest all the limitations of the claimed invention. See MPEP §2143 (Aug. 2001). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Applicants respectfully assert that the examiner has not met his burden.

As noted above, the Office concedes that Rusz does not teach a bypass valve. Lewis and Georgieff do not supplement Rusz to teach a bypass valve. In light of the above, Applicants believe the Office has not met its burden of establishing a *prime facie* case of obviousness. Since the claims include a bypass valve in the system, Applicants respectfully request reconsideration and withdrawal of the rejection.

d. **New claim 43**

Applicants consider new claim 43 patentable over the art of record because neither Rusz nor Lewis discloses or suggests quantitating an anesthetic vapor based on a fingerprint generated from a sensor array. Applicants have found no disclosure of this subject matter in any of the other references of record in this application. Accordingly, Applicants request allowance of claim 43.

CONCLUSION

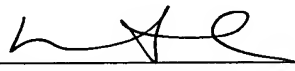
The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant(s) hereby petition(s) for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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